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10/700,910

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Christopher J. Cormack

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09/15/2006

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EXAMINER

TRAN, QUOC A

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,910

Applicant(s)

CORMACK ET AL.

Examiner

Quoc A. Tran

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to Remarks filed 06/23/2006.
2. Claims 1-20 are currently pending in this application. Claims 1, 7, 12 and 16 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-5 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the reason set forth below:

Regarding independent claims 1-5 and 16-20 are not limited to tangible embodiments. Claims 1-5 and 16-20 disclose the process such as, "A method, comprising: **receiving...storing, modifying...outputting, detecting...**" associating with the concept of annotating of media information, are interpreted as software per se, abstracts ideas or mental constructs and not tangibly embodied on a computer readable medium or hardware (see WHAT IS THE CLAIMED: pages 14 and 12-18), set forth descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software to produce a "useful and tangible" result;

(1) "USEFUL RESULT", For an invention to be "useful" it must satisfy the utility requirement of section 101 see MPEP § 2107 and Fisher, 421 F.3d at ___, 76 USPQ2d at 1230

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(citing the Utility Guidelines with approval for interpretation of “specific” and “substantial”),
and

(2) “TANGIBLE RESULT”, For an invention to be “useful” it must satisfy the utility requirement of section 101 see MPEP § 2107 and see Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. US 20040236830A1 filed 05/15/2003 (hereinafter Nelson), in view of King et al. US005600775A issued 02/04/1997 (hereinafter King).

In regard to independent claim 1, receiving an indication that annotation of media information is desired; storing annotation information (see Nelson at page 1 paragraphs [0006] through page 2 paragraph [0014]), describes a systems that provides the ability to be

notified of annotations through electronic mail (email). Furthermore, once the annotations are made, there is no mechanism for reconstructing the annotations for future reference. Thus, if a person misses the videoconference session for whatever reason, the data is lost; to overcome the above coming the above, Nelson'830 discloses an annotation management configured to manage and store annotation data annotation control data and also configured to provide real-time annotation data to clients of a videoconference session is provided. The method initiates with annotating a display region of a user interface associated with a client of the videoconference session. Then, annotating of the display region is detected,

and modifying ... of the media information to reflect a presence of the annotation information (see Nelson at page 1 paragraph [00011] through page 2 paragraph [0014]), discloses the storage server is configured to store the media data and the annotation data, wherein an event database in communication with the media management server is included to capture events associated with the annotation data. The media analysis server is configured to associate the stored annotation data with the captured events to enable reconstruction of the videoconference session based on the captured events and a graphical user interface (GUI) enabled to provide real-time annotation of display data rendered on a display screen is provided. The GUI includes a media display region corresponding to a media signal. The media display region is capable of being annotated by a videoconference participant, wherein the annotation of the media display region generates an event for storage on an annotation management server. The annotation of the media display region further generates a signal presented to remaining videoconference participants in real-time. A control display region enabling a participant to define control properties associated with the media display region is included.

Nelson does not explicitly teach, **and modifying an index of the media information to reflect a presence of the annotation information**, however (see King at col. 2, line 1 through col. 3, line 30, also see Fig. 1), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames. On full motion video playback, the annotations are displayed on the originally annotated frames. The annotations can be manipulated independently of the video information. For example, the annotations and video can be transported separately, while the indexing scheme allows the annotations and the video to be recombined at the receiving station.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of modifying an index of the media information to reflect a presence of the annotation information, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to independent claim 7, incorporates substantially similar subject matter as cited in claim 1 above, and further view of the following, and is similarly rejected along the same rationale,

an interface ...a memory, media information, ...a processor (see Nelson at page 1 paragraph [0008] through page 6 paragraph [0055]), discloses a process, a system, a computer readable media, or a graphical user interface, wherein the annotation data is preserved so that the videoconference session may be reconstructed using computer readable code on a computer readable medium. The computer readable medium is any data storage device that can store data, which can be thereafter read by a computer system. The computer readable medium also includes an electromagnetic carrier wave in which the computer code is embodied. Examples of the computer readable medium include hard drives, network attached storage (NAS), read-only memory, random-access memory, CD-ROMs, CD-Rs, CD-RWs, magnetic tapes, and other optical and non-optical data storage devices. The computer readable medium can also be distributed over a network coupled computer system so that the computer readable code is stored and executed in a distributed fashion),

and to selectively retrieve the annotation information from the memory based on the index information; and a display module to combine the media information and the annotation information for output to a display device, however (see King at col. 2, line 1 through col. 5, line 25, also see Fig. 1), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames. On full motion video playback, the annotations are displayed on the originally annotated frames. The annotations can be manipulated independently of the video information. For example, the

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annotations and video can be transported separately, while the indexing scheme allows the annotations and the video to be recombined at the receiving station. Furthermore, provides input tools in the instruction memory and possibly other input devices in order to store input data into the annotation data structures in the data memory. A graphical element is associated with each annotated data structure. This graphic element is displayed as an overlaying annotation in the video window, where the annotation overlies the video frame, without modifying the video frame during playback of an annotated file.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of selectively retrieve the annotation information from the memory based on the index information; and a display module to combine the media information and the annotation information for output to a display device, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to independent claim 12, incorporates substantially similar subject matter as cited in claims 1 and 7 above, and further view of the following, and is similarly rejected along the same rationale,

Examiner read an article of manufacture in the broadest reasonable interpretation to the claim limitation; which would have been an obvious variant of media information of claims 1 and 7 above, to a person of ordinary skill in the art at the time the invention was made, and

detecting an annotation marker in the index file; retrieving annotation information associated with the annotation marker; and combining the media information and the annotation information to display annotated media information, however (see King at the Abstract and col. 2, line 1 through col. 6, line 65, also see Fig. 1 and 3), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames. During playback, the annotation memory is monitored to detect annotation data structure for indexed data structures currently being displayed. If an annotation data structure is detected for the current indexed data structure, a graphical element overlies the indexed data structure on the display without modifying the indexed data structure. Text process documents can be handled much in the same manner. Also, annotation from several users may be merged and viewed in one batch. Furthermore (see King in detail at col. 6, lines 5-65), discloses the detail of the indexing schema, such as annotation indication of the index, each multimedia indication of the index and so on, so that on full motion video playback, the annotations are displayed on the originally annotated frames. The annotations can be manipulated independently of the video information. For example, the annotations and video can be transported separately, while the indexing scheme allows the annotations and the video to be recombined at the

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receiving station. Furthermore, provides input tools in the instruction memory and possibly other input devices in order to store input data into the annotation data structures in the data memory.

A graphical element is associated with each annotated data structure. This graphic element is displayed as an overlaying annotation in the video window, where the annotation overlies the video frame, without modifying the video frame during playback of an annotated file,

Examiner read the above in the broadest reasonable interpretation to the claim limitation; wherein the annotation marker would have been an obvious variant of annotation indication of the index, to a person of ordinary skill in the art at the time the invention was made.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of detecting an annotation marker in the index file; retrieving annotation information associated with the annotation marker; and combining the media information and the annotation information to display annotated media information, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to independent claim 16, incorporates substantially similar subject matter as cited in claims 1, 7 and 12 above, and further view of the following, and is similarly rejected along the same rationale,

Examiner read the above in the broadest reasonable interpretation to the claim limitation; wherein a point in the index file would have been an obvious variant of marker in the index file of claim 12, thus incorporates substantially similar subject matter, to a person of ordinary skill in the art at the time the invention was made.

In regard to dependent claim 2, querying a user for a source of the annotation information before the storing (see Nelson at page 2 paragraph [0013]), providing real-time annotation data to clients with annotating a display region of a user interface associated with a client of the videoconference session. Then, annotating of the display region is detected. In response to detecting the annotating of the display region, the method includes communicating data corresponding to the detecting of the annotating of the display region to other clients of the videoconference session for real-time presentation. Next, the data corresponding to the detecting of the annotating of the display region is stored. Then, the data corresponding to the detecting of the annotating of the display region is associated with data defining the videoconference session).

In regard to dependent claim 3, incorporates substantially similar subject matter as cited in claims 1, and 7 above, and is similarly rejected along the same rationale.

In regard to dependent claim 4, wherein the annotation information includes control data, text, audio information, graphical information, or video information (see Nelson at page 1 paragraph [0008] through page 6 paragraph [0055]), discloses a process, a system, a

computer readable media, or a graphical user interface, wherein the annotation data is preserved so that the videoconference session may be reconstructed using computer readable code on a computer readable medium.

In regard to dependent claims 5-6, incorporates substantially similar subject matter as cited in claims 1, 7, 12 and 16 above, and is similarly rejected along the same rationale.

In regard to dependent claim 8, a tuner connected to the processor to separate the media information from an input media stream, however (see King at col. 2, line 15 through col. 3, line 35, also see Fig. 1), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames. Also can be characterized as an apparatus (see item 10 (cpu) of Fig. 1) for display and annotation of a file of indexed data structures, wherein types of annotations, which can be created, include free-hand bitmap drawings, text, and audio data. When audio data is used, an icon is used as the graphical element of the annotation data structure, which can be displayed over the indexed data structure to indicate presence of an audio annotation. Also, the annotation graphical element can be positioned on the screen overlaying the indexed data structure using a pointer device which inputs coordinate data for the annotation data structure.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a tuner that connected to the processor to separate the media information from an input media stream, of King's teaching. One of ordinary skill in the art

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would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to dependent claims 9-10, incorporates substantially similar subject matter as cited in claims 3-4 and 7-8 above, and are similarly rejected along the same rationale.

In regard to dependent claim 11, incorporates substantially similar subject matter as cited in claims 1 and 7 above, and further view of the following, and is similarly rejected along the same rationale,

Examiner read a communication link to access annotation content referenced by the annotation information of claim 11 in the broadest reasonable interpretation to the claim limitation; which would have been an obvious variant of an interface to receive annotation information; a memory to store the annotation information, media information, and index information relating to the annotation information and the media information; a processor to retrieve the media information from the memory and to selectively retrieve the annotation information from the memory based on the index information of claims 1 and 7 above, to a person of ordinary skill in the art at the time the invention was made.

In regard to dependent claim 13, incorporates substantially similar subject matter as cited in claims 2-3, 7, 12 and 16 and 7-8 above, and is similarly rejected along the same rationale.

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In regard to dependent claim 14, incorporates substantially similar subject matter as cited in claims 1 and 7 above, and further view of the following, and is similarly rejected along the same rationale,

overlaying the annotation information on the media information, however (see King at col. 2, line 15 through col. 3, line 35, also see Fig. 3), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames.

The annotation data structure includes a graphical element for display overlaying the selected data structure and an indication of an index value for the selected data structure.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of overlaying the annotation information on the media information, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to dependent claim 15, incorporates substantially similar subject matter as cited in claims 1, 7 and 12 above, and further view of the following, and is similarly rejected along the same rationale,

Examiner read blending the annotation information and the media information of claim 15 in the broadest reasonable interpretation to the claim limitation; which would have been an obvious variant of modifying an index of the media information to reflect a presence of the annotation information of claims 1 and 7 above, to a person of ordinary skill in the art at the time the invention was made.

In regard to dependent claim 17, asking for a type of the annotation information before the receiving and storing, however (see King at col. 2, line 15 through col. 3, line 35, also see Fig. 1), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames, wherein types of annotations, which can be created, include free-hand bitmap drawings, text, and audio data. When audio data is used, an icon is used as the graphical element of the annotation data structure, which can be displayed over the indexed data structure to indicate presence of an audio annotation. Also, the annotation graphical element can be positioned on the screen overlaying the indexed data structure using a pointer device which inputs coordinate data for the annotation data structure.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of asking for a type of the annotation information before the receiving and storing, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that

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allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

In regard to dependent claim 18, incorporates substantially similar subject matter as cited in claims 1, 7, 12 and 16 above, and further view of the following, and is similarly rejected along the same rationale.

In regard to dependent claim 19, incorporates substantially similar subject matter as cited in claim 1 above, and further view of the following, and is similarly rejected along the same rationale.

repeating the outputting stored media information based on an associated index file before the detecting a reference to the stored annotation information (see Nelson at page 1 paragraphs [0006] through page 2 paragraph [0014]), describes a systems that provides the ability to be notified of annotations through electronic mail (email). Furthermore, once the annotations are made, there is no mechanism for reconstructing the annotations for future reference. Thus, if a person misses the videoconference session for whatever reason, the data is lost; to overcome the above coming the above, Nelson'830 discloses an annotation management configured to mange and store annotation data annotation control data and also configured to provide real-time annotation data to clients of a videoconference session is provided. The method initiates with annotating a display region of a user interface associated with a client of the videoconference session. Then, annotating of the display region is detected, also (see Nelson at page 1 paragraph [00011] through page 2 paragraph [0014]), discloses the storage server is configured to store the media data and the annotation data, wherein an event database in

communication with the media management server is included to capture events associated with the annotation data. The media analysis server is configured to associate the stored annotation data with the captured events to enable reconstruction of the videoconference session based on the captured events and a graphical user interface (GUI) enabled to provide real-time annotation of display data rendered on a display screen is provided. The GUI includes a media display region corresponding to a media signal. The media display region is capable of being annotated by a videoconference participant, wherein the annotation of the media display region generates an event for storage on an annotation management server. The annotation of the media display region further generates a signal presented to remaining videoconference participants in real-time. A control display region enabling a participant to define control properties associated with the media display region is included.

In regard to dependent claim 20, incorporates substantially similar subject matter as cited in claims 1, 7, 12 and 16 above, and further view of the following, and is similarly rejected along the same rationale,

determining whether the annotation information should be displayed, and combining the media information and the annotation information if the determining determines that the annotation information should be displayed, however (see King at col. 2, line 15 through col. 12, line 60), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames, wherein types of annotations, which can be created, include free-hand bitmap drawings, text, and audio data. When audio data is used, an icon is used as the graphical element of the annotation data structure, which can be displayed over the indexed data structure to indicate presence of an audio

annotation. Also, the annotation graphical element can be positioned on the screen overlaying the indexed data structure using a pointer device which inputs coordinate data for the annotation data structure,

further includes the output comparator (i.e. true, open or not or position within note?)
(See table on col. 8),

Examiner read the above in the broadest reasonable interpretation to the claim limitation; wherein whether the annotation information should be displayed would have been an obvious variant of further includes the output comparator (i.e. true, open or not or position within note?)
(See table on col. 8), to a person of ordinary skill in the art at the time the invention was made.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Nelson's teaching, discloses an annotation management configured to receiving an indication that annotation of media information is desired; storing annotation information and modifying ... of the media information to reflect a presence of the annotation information, to includes a means of determining whether the annotation information should be displayed, and combining the media information and the annotation information if the determining determines that the annotation information should be displayed, of King's teaching. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of media annotation control and/or management and desirable to provide an annotation tool that allows reductions in production time, more effective utilization of resources, and greater communication in general during creation of multimedia products or other large scale indexed data files in real time interaction among developers and /or users (see King at col. 1 lines 25-67).

Response to Arguments

6. Applicant's arguments filed 06/23/2006 have been fully considered but they are not persuasive. The reason is set forth in the current Office Action cited above and further view of the following:

Brief description of cited prior arts:

Nelson et al, discloses an annotation management system wherein the participants can exchange annotation data in real-time, where the annotation data is preserved so that the videoconference session may be reconstructed. It should be appreciated that the present invention can be implemented in numerous ways, including as a process, a system, a computer readable media, or a graphical user interface. An annotation management system configured to manage and store annotation data and annotation control data is provided between the plurality of clients, and the server also included GUI in real-time annotation ion between server and clients (see Nelson at page 1 paragraphs [0008]-[0011] and [0013]).

King et al, discloses the video and annotations method, wherein the he video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames, wherein types of annotations, which can be created, include free-hand bitmap drawings, text, and audio data. When audio data is used, an icon is used as the graphical element of the annotation data structure, which can be displayed over the indexed data structure to indicate presence of an audio annotation. Also, the annotation graphical element can be positioned on the screen overlaying the indexed data structure using a pointer device which inputs coordinate data for the annotation data structure (see King at col. 2, line 15 through col. 12, line 60).

Response to Arguments:

Beginning on page 4/8 of the Remarks (hereinafter the remarks), Applicant argues the following issues, which are accordingly addressed below.

Applicant's arguments, on page 4 of the remarks that **101 should be traverse cause by an improper test and as a whole are use full and produce the practical result.**

The examiner respectfully notes that,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 and 16-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the reason set forth in the previous office action and repeats a above and further view of the following:

Regarding independent claims 1-5 and 16-20 *are not limited to tangible embodiments.* Evident of the language uses in claims 1-5 and 16-20 discloses the process such as, "A method, comprising: **receiving...storing, modifying...outputting, detecting...**" associating with the concept of annotating of media information, are interpreted as software per se, abstracts ideas or mental construct and not tangibly embodied on a computer readable medium or hardware (see WHAT IS THE CLAIMED: pages 14 and 12-18), set forth descriptive material but fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software to produce a "useful and tangible" result;

(1) "USEFUL RESULT", For an invention to be "useful" it must satisfy the utility requirement of section 101 see MPEP § 2107 and Fisher, 421 F.3d at ___, 76 USPQ2d at 1230

(citing the Utility Guidelines with approval for interpretation of “specific” and “substantial”),
and

(2) “TANGIBLE RESULT”, For an invention to be “useful” it must satisfy the utility requirement of section 101 see MPEP § 2107 and see Benson, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”). “[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection.” Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 (“It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . .”).

Therefore the Examiner respectfully maintains the 101 rejections of 1-5 and 16-20 at this time.

Further more Applicant’s arguments, on pages 5-8 of the remarks that the references in combination, do not teach:

(i) modifying an index of the media information to reflect a presence of the annotation information,

(ii) index information relating to the annotation information and the media information,

(iii) detecting an annotation marker in the index file;

(iv) a prima facie case of obvious ness has not been established.

The examiner respectfully disagrees. As for (i) (ii) (iii) and (iv), The examiner respectfully notes that, Nelson et al, discloses an annotation management system wherein the participants can exchange annotation data in real-time, where the annotation data is preserved so

that the videoconference session may be reconstructed. It should be appreciated that the present invention can be implemented in numerous ways, including as a process, a system, a computer readable media, or a graphical user interface. An annotation management system configured to manage and store annotation data and annotation control data is provided between the plurality of clients, and the server also included GUI in real-time annotation ion between server and clients (see Nelson at page 1 paragraphs [0008]-[0011] and [0013]) in combination with, **King et al**, discloses the video and annotations method, wherein the he video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames, wherein types of annotations, which can be created, include free-hand bitmap drawings, text, and audio data. When audio data is used, an icon is used as the graphical element of the annotation data structure, which can be displayed over the indexed data structure to indicate presence of an audio annotation. Also, the annotation graphical element can be positioned on the screen overlaying the indexed data structure using a pointer device which inputs coordinate data for the annotation data structure (see King at col. 2, line 15 through col. 12, line 60).

Also (see King at the Abstract and col. 2, line 1 through col. 6, line 65, also see Fig. 1 and 3), discloses the video and annotations are stored separately that provides an indexing scheme relates the annotations to the video frames. During playback, the annotation memory is monitored to detect annotation data structure for indexed data structures currently being displayed.

Furthermore (see King in detail at col. 6, lines 5-65), discloses the detail of the indexing schema, such as annotation indication of the index, each multimedia indication of the index and so on, so that on full motion video playback, the annotations are displayed on the originally

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annotated frames. The annotations can be manipulated independently of the video information. For example, the annotations and video can be transported separately, while the indexing scheme allows the annotations and the video to be recombined at the receiving station. Furthermore, provides input tools in the instruction memory and possibly other input devices in order to store input data into the annotation data structures in the data memory. A graphical element is associated with each annotated data structure. This graphic element is displayed as an overlaying annotation in the video window, where the annotation overlies the video frame, without modifying the video frame during playback of an annotated file,

Examiner read the above in the broadest reasonable interpretation to the claim limitation; wherein detecting an annotation marker in the index file would have been an obvious variant of those discloses above.

Thus a prima facie case has been established and therefore the Examiner respectfully maintains the rejection of claims 1-20 at this time.

Conclusion

7. ***THIS ACTION IS MADE FINAL.*** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is (571) 272-4103. The examiner can normally be reached on Monday through Friday from 8 AM to 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on (571) -272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran
Patent Examiner
Technology Center 2176
September 11, 2006


WILLIAM BASHORE
PRIMARY EXAMINER